

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CARL D. McCANN

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Appeal No. 1999-2226  
Application No. 08/582,678

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Before GARRIS, DELMENDO, and PAWLIKOWSKI, *Administrative Patent Judges*.  
GARRIS, *Administrative Patent Judge*.

***DECISION ON APPEAL***

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-10, 20 and 21, which are all of the claims pending in this application. Claims 11-19 have been canceled.

### ***BACKGROUND***

The subject matter on appeal relates to a method of fabricating a pack tray for integrated circuit chip packages. The pack tray is intended to be used for shipping integrated circuit chip packages. The method steps include providing a master frame, providing a plurality of modules that are separate from the master frame, and securing the plurality of modules in the master frame to form the pack tray.

Claims 1, 7 and 21 are representative of the claims on appeal and are reproduced below<sup>1</sup>:

1. A method of fabricating a pack tray for integrated circuit chip packages comprising the steps of:

providing a master frame;

providing a plurality of modules that are separate from said master frame; and

securing said plurality of modules in said master frame to form said pack tray.

7. The method of Claim 1 wherein said step for securing includes flowing plastic around said plurality of modules in said master frame.

21. A method of fabricating a pack tray for integrated circuit chip packages comprising the steps of :

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<sup>1</sup>Claims 1 and 21 as set forth in the Appendix to the brief are incorrect. They have been reproduced in this decision correctly. Specifically, in Paper No. 14, claim 1 was amended to include the phrase “to form said pack tray” at the end, yet this phrase was not underlined. This informal amendment should be formalized in any further prosecution of this application. (This amendment was formally proposed in an after final amendment in the parent case, but was not entered.) Appellant also quotes this language as being recited in the claim; see the end of the first paragraph on page 12 of the brief. Claim 21, line 3 “with” should be --and--; this is clearly a copying error from claim 21 presented in Paper No. 14.

forming a master frame and a plurality of modules that are separate from said master frame;

placing said plurality of modules in said master frame; and

securing said plurality of modules to said master frame to form said pack tray.

The prior art relied upon by the Examiner as evidence of obviousness is:

Murphy 5,103,976 Apr. 14, 1992

The admitted prior art as stated on pages 1-2 of the instant specification (AAPA).

Claims 1-10, 20 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Murphy in view of AAPA.

As Appellant states on page 6 of his brief, there are three claim groupings. Claims 1-6, 8-10 and 20 all stand or fall together; claims 7 and 21 are each to be treated separately. Therefore, our discussion will focus on claim 1 as the broadest claim of the first group, and on claims 7 and 21; 37 CFR § 1.192(c)(7)(1997).

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the Appellant and by the Examiner concerning the above noted rejections.

### ***OPINION***

We affirm the rejections of claims 1-6, 8-10, 20 and 21 for the reasons stated below. However, we will not sustain the rejection of claim 7.

We agree with the Examiner, as set out on pages 3-5 of the answer, that Murphy substantially teaches the basic claimed process of forming a tray for the shipping of electronic components. Upon a careful review of the reference, Murphy provides a “master frame” (i.e., tray 10), provides a plurality of “modules” separate from the master tray (i.e., the templates 80, 81), and “secures” the plurality of modules (templates 80, 81) in the master frame (tray 10) to form the pack tray.

Appellant argues the claimed subject matter differs from Murphy because the templates (e.g., 80, 81) are not secured in the master frame, that is, the tray 10 of Murphy. The Appellant's position is that his modules are secured to and become a part of the tray. Therefore, a pivotal consideration on this appeal is the meaning of “securing” the modules in the master frame. For the reasons detailed below, we agree with the Examiner that neither claim 1 nor claim 21 defines over the tray and templates of Murphy.

It is well settled that application claims, in proceedings before the USPTO, are to be given their broadest reasonable interpretation consistent with the specification. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Thus, we look to Appellant's specification for guidance in interpreting the claim language.

We find that at page 2, lines 13 and 14, of the specification, Appellant broadly discloses “securing the plurality of modules in the master frame” and then at lines 19-22 discloses “[i]n **one** fabrication process....To secure the modules in the master frame, plastic is then flowed around the plurality of modules....” (emphasis provided). Appellant also discloses in the flow diagram of Fig. 2, in box 26, “secure modules to master frame”.

Since Appellant clearly discloses that flowing plastic is but one way to secure the modules (indeed, this is a further limitation recited in dependent claim 7), and provides no further definition of what he means by “securing,” we look to the dictionary definition. Webster’s II New Riverside University Dictionary, 1984, defines “secure” at page 1055 “to make tight or firm : FASTEN” (copy of dictionary definition attached to this decision).

Are the templates of Murphy secured, that is, fastened (or made tight or firm), to the tray 10? We conclude that they are. Murphy teaches (see col. 7, line 68 to col 8, line 20) that (1) the template has a vertical *keyway* 83; (2) the vertical keyway 83 *engages*<sup>2</sup> a *key* 92 on the tray 10; (3) a slot 91 in the template *engages* the central beam 31 of the tray 10; and (4) fingers 84 and 85 on the template *engage* the front beam 25 and back beam 26, respectively, of the tray 10 (emphasis provided). Clearly, the template is secured, or fastened, or made tight or firm, to the tray 10 against movement in many directions. Indeed, the template can be moved only in one direction, which is vertically upward. The independent claims on appeal do not expressly or implicitly prohibit this one direction movement.

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<sup>2</sup>Webster’s II New Riverside University Dictionary, 1984, page 433, defines “engage -...7. To *interlock* or cause to *interlock*...”(emphasis provided) (copy of dictionary definitions attached).

Furthermore, the dictionary definitions of “key” and “keyway” relate to a combination of structural elements intended to secure one piece to another.<sup>3</sup> Thus, it is reasonable to regard the key 92 and keyway 83 as means for securing, or engaging, the template to the tray 10 of Murphy.

In light of the foregoing, it is reasonable and consistent with the specification to interpret the securing step of claim 1 to include the various ways that templates 80, 81, engage the tray 10 of Murphy. We here emphasize that Appellant could have further defined the scope of "securing" by making it clear in the specification what is regarded as securing. However, Appellant did not do this.

Appellant urges us to consider that “fabricating a pack tray” clearly indicates that the plurality of modules become part of the pack tray, and that the temporary placement of the templates of Murphy onto the tray 10 do not make them a part of the tray. (see reply brief, pages 2-3). We disagree.

This Board panel concludes that, plainly, the templates do indeed become a part of the pack tray, even if only temporarily. That is, the pack tray resulting from the method of independent claims 1 and 21 is structurally indistinguishable from the template and tray combination of Murphy. While we recognize that patentee does not intend for his templates to be permanently engaged with or secured to his tray, the independent claims do not require the “securing” step to result in permanence. Indeed, the subject specification does not appear to

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<sup>3</sup>Webster’s II New Riverside University Dictionary, 1984, page 663, defines “key -...4. *A device, as a wedge or pin, inserted to lock together structural or mechanical parts...*” and “keyway - 1. *A slot in a wheel hub or shaft for a key...*”(emphasis provided) (copy of dictionary definitions attached).

address the issue of whether the here claimed “securing” is intended to be permanent or temporary. In any event, it is appropriate to here emphasize that it has been decided that it is an error for this Board to add “inferential limitations” to applicant’s claims. See In re Priest, 582 F.2d 33, 37-38, 199 USPQ 11, 15 (CCPA 1978).

Thus, the independent claims on appeal do not recite that the modules are permanently secured to the frame, and it would be improper to read any such limitation into these claims. Likewise, Appellant’s arguments that modules and templates have functions “completely different” from one another (see pages 3-4 of reply brief) are not in any way reflected by the claim language. The claim does not recite any function for the modules. Accordingly, it would be improper to read the function of “each ‘module’ stores a single chip”(reply brief, page 4) into the claim.

Furthermore, it has been established that it is appropriate to reject a chemical process claim that recites no steps not disclosed in a prior patent, even if a new product may be obtained, since it must be due to some step not included in the claim. See In re Sussman, 141 F.2d 267, 270, 60 USPQ 538, 541 (CCPA 1944).

The here claimed process likewise recites no steps not disclosed in a prior patent, that is, Murphy. Although Appellant argues he fabricates a pack tray different from Murphy’s, we can not find any claim language supporting this argument. If Appellant does ultimately fabricate a different pack tray from Murphy’s, it must be due to some step not included in claim 1.

With respect to claim 21, its language is substantially the same as claim 1. However, claim 21 calls for the additional step of “placing said plurality of modules in said master frame.”

We conclude that a reasonable interpretation of this language encompasses placing the templates 80, 81 onto the tray 10 of Murphy. The step of engaging patentee's key 92 with keyway 83, the slot 91 with the beam 31, and so on, satisfies the step of "securing said plurality of modules in said master frame to form said pack tray."

In our analysis of the Examiner's § 103 rejection of claims 1 and 21, we have not relied upon AAPA. In fact, this analysis leads us to conclude that claims 1 and 21 lack novelty with respect to Murphy. Nevertheless, it has been firmly established that a lack of novelty is the ultimate of obviousness, and evidence establishing a lack of novelty in a claimed invention necessarily evidences obviousness. See In re Fracalossi, 681 F. 2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

Thus, for the reasons detailed above, it is appropriate to sustain the Examiner's § 103 rejection of claims 1 and 21 as being unpatentable over Murphy in view of AAPA.

However, we agree with the Appellant that there is no motivation to secure the templates of Murphy to the tray 10 by flowing plastic around said plurality of modules (i.e., templates) in said master frame (i.e., tray 10), as recited in claim 7. Although AAPA teaches that one flows plastic around the metal master mold, there is no disclosure of why this step is performed. Apparently, it is not for the purpose of securing parts of the packing tray together since the packing tray of the admitted prior art is a single metal piece machined to provide apertures, ridges, and recessed areas. In any event, Murphy does not teach that the templates remain attached to the tray after facilitating the packing of the chips into the tray 10. Thus, no reason exists for combining the teachings of Murphy and AAPA. Under these circumstances, we cannot



accept the Examiner's apparent position that it would have been *prima facie* obvious to secure the templates to the tray in Murphy by flowing plastic around same.

In light of the foregoing, we cannot sustain the Examiner's § 103 rejection of claim 7.

### ***CONCLUSION***

The decision of the Examiner to reject claims 1-6, 8-10, 20 and 21 under 35 U.S.C. § 103 over Murphy in view of AAPA is affirmed. The decision of the Examiner to reject claim 7 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

### ***AFFIRMED-IN-PART***

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| BRADLEY R. GARRIS           | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
| ROMULO H. DELMENDO          | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
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| BEVERLY A. PAWLIKOWSKI      | ) |                 |
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